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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,289	03/25/2004	Akinori Iwase	016907-1600	5194

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FOLEY AND LARDNER LLP
SUITE 500
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WASHINGTON, DC 20007

EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/808,289	Applicant(s) IWASE ET AL.	
	Examiner. Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-29, 37-40, 42, 43 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29, 37-40, 42, 43 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/07 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 25-29, 37-40, 42, 43 and 48-50 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25-29 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 25 includes the limitation in lines 6-8 "a

printer that performs the trial preceding print by printing the image data in response to the selection of the trial printing button and performs the printing of all pages of the image data". According to the applicant's specification, only one designated page is printed when the trial printing button is selected (pages 21-22, lines 21-27, 1-8). The specification does not support printing all of the pages in response to selection of the trial printing button.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-29, 37-40, 42, 43 and 48-50 rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda '157 in view of Naito '107.

Referring to **claim 25**, Yoneda '157 discloses an image forming system comprising:

a control panel (control display panel 117, col. 14, lines 63-66) including a first touch screen menu including a trial printing button configured to, when user selected; initiate a trial preceding print of a page of image data without an additional user selection (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7) and a printing button configured to, when selected by a user, initiate printing of all pages of the image data in

response to the selection of the printing button (All print, see Fig. 12, col. 17, lines 63-66);

a printer that performs the trial preceding print by printing the image data in response to the selection of the trial printing and performs the printing of all pages of the image data button (col. 17-18, lines 64-68, 1-7, can be selected to print all or partial);

a controller that sets a desired specification according to operation of the control panel after the printer performs the trial preceding print (Fig. 11 shows printing options), and deletes the image data after the printing of all pages (inherent that the printing system of Yoneda '157 must clear unnecessary data to provide storage space for future print data);

wherein the printer is configured to print all pages of the image data according to the desired specification set by the controller (the document can be printed and then printed again).

Yoneda '157 does not disclose expressly that setting a desired specification includes print density information.

Naito '107 discloses setting print density information (44c of Fig. 9, col. 6, lines 9-18).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to allow the user to set print density information. The motivation for doing so would have been to allow the user to print darker or lighter documents. Therefore, it

would have been obvious to combine Naito '107 with Yoneda '157 to obtain the invention as specified in claim 25.

Referring to **claim 26**, Yoneda '157 discloses a receiver that receives the image data using a communication line (col. 11, lines 4-15).

Referring to **claim 27**, Yoneda '157 discloses a scanner for scanning at least one original page to obtain a digital image thereof as the page of image data (scanner interface 40 of Fig. 3), and a memory for storing image data (page memory, see Fig. 6).

Referring to **claim 28**, Yoneda '157 discloses wherein the control panel further includes a second touch screen menu displayed after the printer performs the trial preceding print, the second touch screen menu including a print button configured to, when user selected, initiated printing the page of image data according to the desired specification set by the controller (see Fig. 11, the document can be printed and then printed again).

Referring to **claim 37**, see the rejection regarding claim 25 above.

Referring to **claim 38**, see the rejection regarding claim 26 above.

Referring to **claim 39**, see the rejection regarding claim 27 above.

Referring to **claim 40**, see the rejection regarding claim 28 above.

Referring to **claim 42**, Yoneda '157 discloses a process for performing a trial preceding print in an image forming apparatus, comprising:

receiving an instruction in response to a selection of a touch screen trial printing button on a control panel (control display panel 117, col. 14, lines 63-66) to initiate a trial preceding print of image data without an additional user selection (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7);

receiving an instruction in response to a selection of a touch screen printing button on the control panel to initiate printing of all pages (All print, see Fig. 12, col. 17, lines 63-66);

performing the trial preceding print with a printer by printing the image data in response to the selection of the trial printing (col. 17-18; lines 64-68, 1-7, can be selected to print all or partial);

performing the printing of all pages of the image data in response to the selection of the printing button (All print, see Fig. 12, col. 17, lines 63-66);

displaying a plurality of print value buttons on the control panel after the printer performs the trial preceding print, the plurality of print value buttons configured to be user selectable to permit the user to change a specification for printing from a specification used for the trial preceding print (Fig. 11 shows printing options), and deleting the image data after the printing of all pages (inherent that the printing system of Yoneda '157 must clear unnecessary data to provide storage space for future print data), and

printing the image data with the printer according to the changed specification if the user changes the specification from the specification used for the trial preceding print (the document can be printed and then printed again).

Referring to **claim 43**, Yoneda '157 discloses selecting a touch screen print button on the control panel to, if the user does not change the specification for printing, initiate printing of the image data according to the specification used for the trial preceding print (see Fig. 11, the document can be printed and then printed again).

Referring to **claim 48**, Yoneda '157 discloses the control panel comprising a touch screen menu.

Naito '107 discloses a density button configured to, when user selected, set the print density information (44c of Fig. 9, col. 6, lines 9-18).

Referring to **claim 49**, see the rejection of claim 48 above.

Referring to **claim 50**, see the rejection of claim 48 above.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda '157 and Naito '107 as applied to claim 25 above, and further in view of well known prior art.

Referring to **claim 29**, Yoneda '157 discloses an image forming system comprising a printer, but does not disclose expressly a plurality of data processors that transfer images to the printer.

Official Notice is taken that it is well known and obvious in the art to connect a plurality of computers to a printer (See MPEP 2144.03). The motivation for doing so would have been to allow printing from computers connected to the printer. Therefore, it would have been obvious to combine well known prior art with Yoneda '157 as in claim 21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

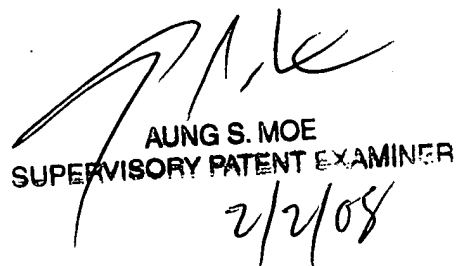
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PKH

A large, stylized handwritten signature in black ink, likely belonging to the Patent Examiner.A handwritten signature in black ink, appearing to read 'A. Moe', positioned above the printed name and date.

AUNG S. MOE
SUPERVISORY PATENT EXAMINER
2/2/08